

would be achieved by simply adding together the effects caused by the amounts separately. Thus, the claim containing this term is not indefinite.

#### **The Rejection under 35 U.S.C. §112, second paragraph**

It is believed that the rejection under 35 U.S.C. §112, second paragraph, is rendered moot by the above amendments to claims 8 and 11.

#### **The Rejections under 35 U.S.C. §102 and 35 U.S.C. §103**

The several rejections under 35 U.S.C. §102 and 35 U.S.C. §103 are based solely or primarily upon Gers-Barlag (U.S. Patent No. 5,952,391; assigned to Beiersdorf AG) or Beiersdorf AG, DE 19753983. The effective prior art date of US '391 under 35 U.S.C. §102(e) is Dec. 4, 1998, and the effective prior art date of DE '983 under 35 U.S.C. §102(a) is June 10, 1999. Applicants submit herewith a 37 C.F.R. §1.131 Declaration swearing back of the earlier of these dates by establishing a prior constructive reduction to practice in a WTO country, which has not been abandoned, suppressed or concealed. Thus, these references are eliminated as prior art and the rejections are rendered moot. This should not be interpreted as an admission that the rejections would be proper if the references were prior art and applicants reserve the right to put forth such arguments should they be necessary.

#### **The New Claims**

The new claims directed to methods for treating or preventing viral infection are not anticipated or rendered obvious over the references relied upon in rejecting claims 1-15, even if they were effective as prior art.

As set forth in more detail below, none of the references of record teach or suggest that isoquercitrin has antiviral activity and, therefore, none could anticipate or suggest a method for treating or preventing viral infection using an anti-virally effective amount of isoquercitrin.

Gers-Barlag (US '391) teaches the use of flavonoids, including isoquercitrin, in conjunction with UV protection compounds to stabilize such compositions due to their anti-oxidant effect; see, e.g., col. 4, lines 45-65, and col. 7, lines 34-35.

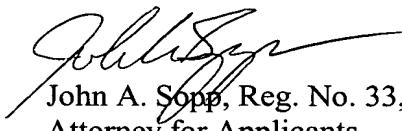
Beiersdorf AG (DE '983) is similar to Gers-Barlag. It teaches only that isoquercitrin is useful as a radical scavenger and/or antioxidant. There is no teaching or suggestion therein that isoquercitrin has any anti-viral activity.

The Bean reference (US '782) was cited based on the allegation that it "teaches flavonoid containing compositions that has [sic] antiviral properties against herpes simplex virus." What Bean actually teaches is that herpes simplex virus can allegedly be treated using an extract of mountain ash berries. The extract is prepared by mixing the crushed berries with isopropyl alcohol. The reference states that "it is not known what the active ingredients are that are effective in suppressing the herpes simples [sic] virus" and then goes on to provide a partial list of 13 compounds and classes of compounds which are known to be chemicals existing in the berries, one of these being isoquercitrin; see, col. 2, lines 10-20. Significantly, Bean also states that it is only the isopropanol extract which has the desired effect but does not state or suggest that isoquercitrin or any other candidate is present also in this extract. Because Bean fails to teach that isoquercitrin is necessarily in the extract and fails to teach the isoquercitrin is the active ingredient, it cannot suggest that isoquercitrin has antiviral activity and, thus, cannot suggest the claimed method. At most, Bean might suggest that one of ordinary skill in the art try any of the chemicals and chemical classes to see if they have antiviral activity. Such is not a sufficient suggestion to support a rejection under 35 U.S.C. §103; see, e.g., In re Geiger, 2 USPQ2d 1276 (Fed. Cir. 1987) and In re Dow Chemical Co., 5 USPQ2d 1529 (Fed. Cir. 1988).

For the reasons stated above, it is respectfully submitted that the newly added method claims are additionally distinguished from the prior art of record under 35 U.S.C. §102 and 35 U.S.C. §103 and any rejection maintained on those grounds should not be extended to these claims.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

Respectfully submitted,



John A. Sopp, Reg. No. 33,103  
Attorney for Applicants  
MILLEN, WHITE, ZELANO & BRANIGAN, P.C.  
Arlington Courthouse Plaza 1  
2200 Clarendon Boulevard, Suite 1400  
Arlington, VA 22201  
Direct Dial: 703-812-5315  
Facsimile: 703-243-6410  
Email: sopp@mwzb.com

JAS/bgk

**Filed: February 15, 2001**

K:\Pat\Merck\1900\amend